

Application No. 10/565,086
Amendment Dated 12/31/2008
Reply to Office Action of 07/01/2008

REMARKS/ARGUMENTS

By this Amendment, claims 3, 8, 11, 12, 13, 17, 20, and 28 are amended. Claims 1-28 are pending.

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

Rejections under 35 USC 112 second paragraph

Claims 1-28 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner argues that the (OCO)n structural piece is unclear.

However, the criteria for entering and sustaining a § 112, second paragraph rejection is well stated in In re Moore, 169 USPQ 2361 238, (CCPA 1971) as:

Any analysis in this regard should begin with the determination of whether the claims satisfy the requirements of this second paragraph.

This first inquiry therefor is merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.

The reasoning of In re Moore has been upheld by the Court of Appeals for the Federal Circuit (CAFC). In Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 USPQ. 81, 94 (CAFC 1986) it was stated:

" . . if the claims read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more." (citing Shatterproof Glass Corp. v. Libbey Owens Ford. Co. 225 USPQ 634, 641 (CAFC 1985)).

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Thus, whether a claim is in compliance with the second paragraph of § 112 requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.

Here, one of ordinary skill in the art would understand what is claimed, given the teachings of the Specification and the claim as written. It is submitted that the claims are definite. Reconsideration and withdrawal of the rejection is respectfully requested.

The Examiner further argues that the term "substantially free" is indefinite, allegedly because terms of degree, such as "substantial" are indefinite when the specification lacks "explicit guidelines" to distinguish from things which are not so, Ex parte Oetiker, 23 USPQ2d 1651, 1655 (1990), and Seattle Box v. Industrial Crating, 221 USPQ 568, 574.

However, it should be noted that breadth of terminology and indefiniteness are not the same. In re Borkowski, 164 USPQ 642 (CCPA 1970). Broad terminology may be used provided the "metes and bounds" can be determined from the claim language. In re Goffe, 188 USPQ 131, 135 (CCPA 1975).

Here, one of ordinary skill in the art would understand what is claimed, given the definition of the term "substantially free" clearly provided in the Specification (page 7, lines 26-28):

The "compound substantially free of Δ^2 isomer" refers to the compound containing the content of Δ^2 isomer in less than about 10% of the compound plus the isomer, preferably less than about 3% and more preferably less than about 0.4%.

In the present situation, the Examiner has objected to the use of the term "substantially free". However, in view of the case law cited above, the claims as presently before the Examiner and the above explanations and/or arguments, it is respectfully submitted that the claims presently pending in this application comply in all respects with the requirements of 35 U.S.C. § 112, second paragraph and that the rejection based on this section of the patent statutes should be withdrawn.

With regard to claim 12, the Examiner argues that the Z-superscript-minus in first line of step (c) of claim 12 is presumably in error. In response, claim 12 has been amended to remove

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the "minus" superscript from line 1 of step (c).

With regard to claim 12, the Examiner argues that the "formula II" at the end of claim 12 is incorrect. In response, claim 12 has been amended to remove the recitation of "formula II" and replace with formula "I(i) or I(ii)".

With regard to claim 13 the Examiner argues that the word "is" is probably missing from before the claim 13 formula. Claim 13 has been amended herein to recite "is" before the formula.

Objection to the Specification

The Examiner objects to the abstract, allegedly because it refers to the "Delta A2 isomer" which is not correct.

The Examiner's attention is drawn to the replacement abstract submitted herewith, in which the recitation of "delta A2" has been amended to Δ^2 . Reconsideration and withdrawal of the objection is respectfully requested.

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For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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Please charge or credit our
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